

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Scott R. Presnell et al.

Confirmation No.: 9291

Application No.: 09/397,846

Group Art Unit: 1647

Filing Date: September 27, 1999

Examiner: David S. Romeo

For: MAMMALIAN TRANSFORMING GROWTH FACTOR BETA - 9

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
BASED ON EVIDENCE THAT A REPLY WAS TIMELY MAILED OR FILED**

Pursuant to MPEP 711.03(c)(I)(B), Applicant hereby petitions to withdraw the holding of abandonment on the basis that a petition for extension of time was timely and properly submitted, but was mishandled upon receipt at the USPTO.

On December 16, 2003, the petition for an extension of time was sent by Express Mail in a package that also contained filing documents for a continuation application. A copy of the petition for an extension of time is attached as Exhibit A. A list of the contents of the Express Mail package, indicating, as item 8, a Petition and Fee for Extension of Time for USSN 09/397,846 (in duplicate) is attached as Exhibit B. In compliance with MPEP 201.06(c)(X), the petition for an extension of time was filed as a separate paper, and was clearly directed to the present application.

Evidence that the USPTO timely received the Express Mail package, including the petition for an extension of time, is found in the file history for US Application Serial No. 10/738,929, the continuation application filed along with the petition on December 16, 2003. The item labeled "Transmittal of New Application" is stamped as received on December 16, 2003, and includes at page 5 the Petition and Fee for Extension of Time directed to the present application.

The USPTO apparently failed to direct the petition to the proper application. Accordingly, the present application was abandoned as of September 17, 2003, creating a break in the copendency necessary to perfect the priority claim of the continuing application.

As set out in MPEP 206.06(c)(XI), the prior nonprovisional application is not automatically abandoned upon filing of a continuing application. Applicants therefore were not concerned when they received the Notice of Abandonment for failure to reply in the present application

(attached as Exhibit C). Additionally, because the Notice of Abandonment provided no indication of the date of abandonment, Applicants remained unaware of the break in copendency.

In an Office Action mailed May 28, 2009, in US Application Serial No. 11/557,689, which claims priority through the present application, the Examiner pointed out the lack of copendency (see the Office Action attached as Exhibit D).

In their reply of October 28, 2009, Applicants traversed the rejection of priority, pointing out that the petition for extension of time had been properly and timely filed (see Remarks attached as Exhibit E).

The Examiner maintained his rejection of priority based on lack of copendency in the Final Rejection mailed January 5, 2010. Upon consideration of this Final Rejection, Applicants reviewed the Patent Application Information Retrieval system records and discovered that the properly filed petition had never been considered, and in fact, had been placed in the record of the wrong application. Applicants recently further identified that the petition fee was not collected from Applicants' deposit account.

Based on the USPTO's failure to consider the properly and timely filed petition for an extension of time, Applicants respectfully request that the USPTO withdraw the holding of abandonment on September 17, 2003, and change the date of abandonment to December 17, 2003, to properly reflect the requested extension of time.

The Commissioner is hereby authorized to charge any deficiency in the fees associated with this communication to Deposit Account No. 23-3050.

Date: May 4, 2010

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